

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:
Woodward, et. al.

Serial No: 08/876,937

Filed: June 16, 1997

For: NON-ACIDIC CYCLOPENTANE
HEPTANOIC ACID, 2-CYCLOALKYL OR
ARYLALKYL DERIVATIVES AS
THERAPEUTIC AGENTS

Honorable Commissioner of Patents and Trademarks

Washington, D.C. 20231



Group Art Unit: 1621

Examiner: Peter O'Sullivan

13/D
P.80
4/15/99
(NE)

Okay to enter, No
April 23, 1999

AMENDMENT

Sir:

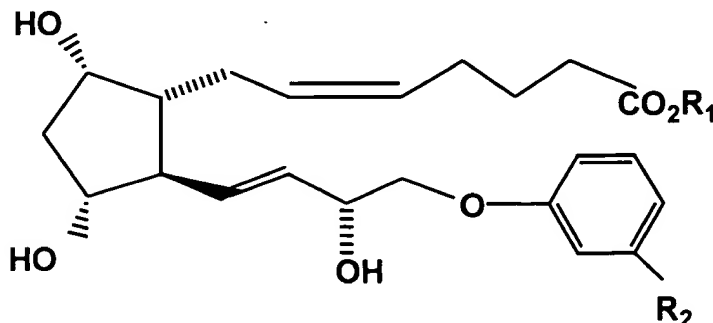
In response to the Office Action of March 2, 1999, the following amendment is offered.

Please add the following claim.

(New Claim) 46. A method of treating glaucoma and ocular hypertension which comprises topically administering to the affected eye a therapeutically effective amount of cyclopentane heptenoic acid, 5-cis-2-(3- α -hydroxy-4-m-chlorophenoxy-1-trans-butenyl)-3,5-dihydroxy [1_{α} , 2_{β} , 3_{α} , 5_{α}].

REMARKS

The present invention provides a method of treating glaucoma and ocular hypertension which comprises topically administering to the affected eye a therapeutically effective amount of a compound of formula:



wherein R_1 = hydrogen, a cationic salt moiety, a pharmaceutically acceptable amine moiety or C_1 - C_{12} alkyl cycloalkyl or aryl; and R^2 = Cl or CF_3 . (See claim 26.)


Also claimed are topical compositions for use in the method of the present invention. (See claim 34.)

The above new claim 46 was copied at the suggestion of the Examiner. Under 37 CFR § 1.605(a) applicants have no choice but to copy such claim verbatim. "Failure or refusal of an applicant to timely present the suggested claim shall be taken without further action as a disclaimer by the applicant of the invention defined by the suggested claim."

The Examiner has again rejected claims 26, 28-34 and 36-45 under 35 USC § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The applicants have responded to this rejection in the reply filed on August 28, 1998. The applicants continue to rely on this response to overcome the Examiner's rejection under 35 USC § 112, first paragraph, but reserve their right to file a further response to this rejection during the shortened statutory period of three months for reply to this final action.

The Examiner has rejected claims 26-45 under 35 USC § 102(e) as being anticipated by Bishop '383. Again, the applicants have responded to this rejection in their reply filed on August 28, 1998, and continue to rely on their arguments against the basis of this rejection. However, the applicants reserve their right to file further arguments against this rejection within the shortened statutory period for response to this final action.

Respectfully Submitted,



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CERTIFICATE OF MAILING

I HEREBY CERTIFY THAT THIS CORRESPONDENCE IS, ON THE DATE SHOWN BELOW, BEING DEPOSITED WITH THE UNITED STATES POSTAL SERVICE WITH SUFFICIENT POSTAGE AS FIRST CLASS MAIL IN AN ENVELOPE ADDRESSED TO: COMMISSIONER OF PATENTS AND TRADEMARK, WASHINGTON, D.C. 20231
on 4/1/99 Signature of Person Making Deposit: Bonnie Ferguson
Date: 4/1/99 Bonnie Ferguson

GP 1621 #13
DOCKET NO. 16955DIVCONCIPCON(AP)
PATENT

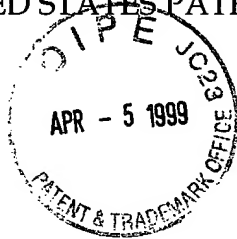
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Group Art Unit: 1621

Examiner: Peter O'Sullivan

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MATRIX CUSTOMER
SERVICE CENTER

TRANSMITTAL LETTER

Hon. Commissioner of Patents and Trademarks
Washington, D.C. 20231

Dear Sir:

Transmitted herewith is an Amendment in the above identified application.

[] No additional fee is required.

[x] The fee has been calculated as shown below:

CLAIMS	COLUMN A Claims Remaining After Amendment	COLUMN B Highest Number Previously Paid For	COLUMN C Extra	Rate	Fee
Total	22	21	= 1	x \$18	\$18.00
Independent	4	4	= 8	x \$78	\$00.00
[] First Presentation of Multiple Dep. Claim x \$260 =					
					Total Additional Fee \$18.00

- * If the entry in Col. A is less than the entry in Col. B, write "0" in Col. C
** If the highest number previously paid for IN THIS SPACE is less than 20,
write "20" in this space
*** If the highest number previously paid for IN THIS SPACE is less than 3,
write "3" in this space

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16955DIVCONCIPCON(AP)
Serial No. 08/876,937

The Commissioner is hereby authorized to charge payment of any additional fees required under 37 CFR 1.16, or credit any overpayment, to Deposit Account No. 01-0885. A duplicate of this sheet is enclosed. THIS IS NOT AN AUTHORIZATION FOR PAYMENT OF ANY ISSUE FEES.

RJ Baran

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